

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/127,059	07/31/98	LEONARDI	A 648/1D340-US
			EXAMINER

HM12/0815

ROBERT C SULLIVAN
DARBY & DARBY
805 THIRD AVENUE
NEW YORK NY 10022

BERNHARDT, E	PAPER NUMBER
ART UNIT	19

1624

DATE MAILED: 08/15/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6/12/01
- ☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above, claim(s) 6-18 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1, 2, 4, 5 and 21 is/are rejected.
- ☒ Claim(s) 3, 19-20 is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 18
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

Art Unit: 1624

In view of applicants' response filed 6/12/01 the following applies.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. It is still not clear what the second ring fused to the benzene ring is. To what "two members of the group" are applicants referring that together form a ring?

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 21 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Ward. While applicants have deleted the 2nd species in claim 21, note that the first species is rendered obvious for reasons given in previous actions and was also provisoed out of main claim 1. See proviso 2.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Plilai in view of van der Stelt for reasons of record. As stated in the previous action H vs Me is not considered a patentable difference. The claim language reads on 4- (methyl-substituted)phenylpiperazine .

The following anticipations apply in view of the newly cited references filed after the mailing of a first office action.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by references 8,9 or 12. **Each** of the references submitted 2/20/01 disclose compounds within the instant scope

Art Unit: 1624

for various pharmacological uses. In Patel in Table 1 on p.119 see the 5 substituted phenyl derivatives as "R". In Ananthanarayan see no.51 on p.35. In Vadodaria see nos.16,18 and 20.

Claims 3,19 and 20 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

This application contains claims 6-18 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE** MONTHS from the mailing date of this action. In the event a first reply is filed within **TWO** MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Application/Control Number: 09/127059

Page 4

Art Unit: 1624

Finality is deemed proper notwithstanding the new grounds of rejection applied above consistent with procedure set forth in MPEP 609 B(2) where IDS is provided after a first office action accompanied by a fee.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

E Bernhardt
EMILY BERNHARDT
PRIMARY EXAMINER
